

REMARKS

Status of the Claims

Claims 8-13 and 21-33 are pending in the application. Claim 21 is currently amended. Claims 10-13 are indicated by the Examiner in the Office Action to be directed to allowable subject matter. Reconsideration and allowance of all of the pending claims is respectfully requested.

New matter is not being added to the application by way of this amendment. The amendment to claim 21 is editorial and does not change the scope of the claim. Accordingly, no new matter is added and entry of this amendment is respectfully requested.

Objections

The Examiner objects to the Abstract of the Disclosure because it is not in single paragraph format. The Abstract is currently replaced with a new Abstract that addresses the Examiner's objection. Withdrawal of this objection is respectfully requested.

The Examiner also objects to claim 21 over the term: "processed." Claim 21 is currently amended to address the Examiner's objection. Withdrawal of this objection is respectfully requested.

Claim Rejections - 35 U.S.C. §102/§103

Claims 8 and 9 are rejected under 35 U.S.C. §102(b) as being anticipated by JP '103 (JP 57-145103). Claims 21-33 are rejected under 35 U.S.C. §102(b) as being anticipated by,

or in the alternative, under 35 U.S.C. §103(a) as obvious over JP '103. Applicants respectfully traverse each of these rejections for the following reasons.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, citing *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[T]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03. Applicants respectfully submit that all of the limitations of the present claims are not disclosed or suggested by the prior art.

JP '103 does not disclose or suggest using an organic active metal catalyst to polymerize a diene monomer as recited in claim 8, to produce an active conjugated diene polymer with an active metal at a terminal of the polymer chain, and then reacting a polar-group-containing compound with the active conjugated diene polymer to produce a polar-group-containing conjugated diene polymer with a polar group at a terminal of a polymer chain. Accordingly, all of the limitations of the present claims are not disclosed or suggested by the prior art. Therefore, neither a case of anticipation nor a case of *prima facie* obviousness has been made out, and Applicants respectfully submit that withdrawal of the pending prior art rejections is required.

Claims 8 and 9

JP '103 discloses a modified polymer obtained by addition-reacting polyisoprene, which is obtained by polymerizing isoprene and a lithium-containing catalyst with maleic anhydride, and that can be used as a cyclized polymeric material. However, JP '103 does not disclose or

suggest the process of producing a polar-group-containing cyclized rubber recited in claim 8. Claim 8 of the present application recites a process for producing a polar-group-containing cyclized rubber, wherein a polar-group-containing compound is reacted with a polymer having an active metal at a terminal of the polymer chain. This then produces a polar-group-containing conjugated diene polymer having, at a terminal of a polymer chain, a polar group originating from the polar group in the polar-group-containing compound. JP '103 contains no mention of such a process.

In addition, comparative examples 1 and 2 of the present application disclose examples of a modified isoprene polymer that are similar to that disclosed in JP '103. It is also described in the present specification that primer, which uses the modified isoprene obtained in each of the comparative examples 1 and 2, was poor in dispersibility of titanium oxide. Thus, the smoothness of the primer layer was poor, resulting in insufficient adhesiveness to paint. See e.g., specification, pages 42-44.

Accordingly, JP '103 does not disclose all of the steps of the process recited in claims 8 and 9 of the present application. Applicants respectfully submit that the rejection of claims 8 and 9 over JP '103 must be withdrawn.

Claims 21-33

Claims 21-33 are directed to polar-group-containing cyclized rubbers that are produced by the process recited in claim 8 or 11. As described above, a modified polymer produced by the method disclosed in JP '103 is different from the polar-group-containing cyclized rubber obtained by the process recited in claim 8 or 11. The JP '103 and the present processes are

different depending on whether or not a polar group is present at a terminal of the respectively formed polymers.

In addition, because the presently claimed polar-group-containing cyclized rubber has a terminal polar group, it can achieve various advantageous effects when used, for example, as a primer. The produced rubber can form a primer layer that has good smoothness and good adhesiveness to the paint. In contrast, the modified polymer obtained by the method disclosed in JP '103 does not achieve such effects since the polymer does not have a terminal polar group.

Accordingly, the prior art does not disclose or suggest all of the limitations of the presently pending claims. Therefore, neither a case of anticipation, nor a case of *prima facie* obviousness has been established. Applicants respectfully submit that withdrawal of the pending prior art rejections, and allowance of the application is required.

Conclusion


Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicant(s) respectfully petition(s) for a three (3) month extension of time for filing a reply in connection with the present application, and the required fee of \$1020.00 is attached hereto.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Mark Konieczny (Reg. No. 47,715) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.14; particularly, extension of time fees.

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Respectfully submitted,

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